UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,524	03/31/2006	Oleg Illich Epshtein	841/005	6989

83336 7590 08/04/2010

Kaplan Gilman & Pergament LLP
1480 Route 9 North
Woodbridge, NJ 07095

EXAMINER	
PIHONAK, SARAH	
ART UNIT	PAPER NUMBER
1627	
MAIL DATE	DELIVERY MODE
08/04/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/574,524	EPSHTEIN, OLEG ILLICH	
	Examiner	Art Unit	
	SARAH PIHONAK	1627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 June 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This application, filed on 3/31/2006, is a national stage entry of PCT/RU04/00374, filed on 9/27/2004.

Priority

This application claims foreign priority to Application No. 2003129126, filed on 10/1/2003.

Response to Remarks

1. Applicant's arguments filed 6/7/2010 have been fully considered but they are not persuasive. The Applicants have argued that the RU ‘006 patent does not anticipate claim 17, because every limitation of claim 17 is not inherently or explicitly met by RU ‘006. The Applicants have asserted that RU '006 does not disclose combining a potentiated morphine with a therapeutic dose to enhance the effectiveness of morphine. The examiner respectfully disagrees. The RU ‘006 patent discloses a method of combining potentiated morphine with the habitual morphine dose to enhance effectiveness of treating withdrawal symptoms; the Applicants have not cited a specific dosage in the claim regarding the therapeutic dose. As the treatment taught by RU '006 is therapeutic, the habitual morphine dose disclosed by RU ‘006 is therapeutic. As the RU ‘006 patent teaches a therapeutic treatment of withdrawal symptoms which comprises administration of potentiated morphine with a habitual dose of morphine, RU ‘006 anticipates claim 17. The rejection was proper and is maintained, for reasons of record. For Applicant's convenience, this rejection will be reiterated in the office action.

2. Applicant's arguments, regarding the rejection of claims 14-16, 18, and 19 under 35 USC 103(a) have been fully considered, but are not found persuasive. The Applicant's arguments regarding this rejection rely upon the Applicant's assertion that the RU '006 patent does not disclose combination of potentiated morphine with a therapeutic dose of morphine. As discussed supra, the RU '006 patent discloses combination of potentiated morphine with a habitual dose of morphine; as the claims do not cite a specific range or value for a therapeutic dose of morphine, the citation of a therapeutic dosage is not distinguishable from a habitual dosage. Additionally, as the combination of potentiated morphine with the habitual dosage as disclosed by the RU '006 patent is for therapeutic treatment, the habitual dosage disclosed by the RU '006 patent constitutes a therapeutic dose. The RU '052 patent teaches a method of treating withdrawal symptoms comprising administration of ethanol which has been diluted by homeopathic methods; therefore, as the RU '006 discloses the combination of potentiated morphine with a therapeutic dose of morphine for treatment, and the RU '052 patent teaches treatment comprising administration of a homeopathic dose of alcohol, it would have been prima facie obvious to one of ordinary skill in the art, at the time of the invention, to combine a therapeutic dose of ethanol with a potentiated dose, because the prior art teaches that such a combination is an effective treatment. As such, the rejection under 35 USC 103(a) was proper and is maintained, for reasons of record. For Applicant's convenience, this rejection will be reiterated below.

3. Applicant's arguments, regarding the rejection of claims 2-13 under 35 USC 103(a) have been considered, but are not found persuasive. Regarding this rejection,

the Applicant's have reiterated the arguments presented for the rejection under 35 USC 102(b) and 35 USC 103(a) for claims 14-16, 18, and 19. As discussed supra, the examiner respectfully disagrees. US Patent No. 2003/0099636 and US Patent No. 7,572,441 (English language equivalent of PCT/RU02/00369) teach that compounds such as phenazepam, diazepam, and hydrocortisone are active pharmaceutical agents used for the treatment of various medical conditions; as these compounds are used therapeutically, as well as morphine and ethanol, it would have been prima facie obvious for one of ordinary skill in the art, at the time of the invention, to combine a potentiated dose of phenazepam, diazepam, hydrocortisone, or cyclophosphamide with a therapeutic dose, because the prior art discloses that this combination is therapeutically successful for morphine. As morphine, ethanol, phenazepam, diazepam, hydrocortisone, and cyclophosphamide are all used for therapeutic purposes, one of ordinary skill in the art would have expected success in applying the method disclosed by the RU '006 patent with these agents, because the RU '006 patent discloses that this method is successful for morphine. As such, the rejection under 35 USC 103(a) was proper and is maintained, for reasons of record. This rejection will also be reiterated below. Accordingly, this action is made FINAL.

The rejection of claims 2-19 over the claims of co-pending Application No. 09/117838 is maintained, for reasons of record, and will be reiterated in the office action.

4. Claims 2-19 were examined.

5. Claims 2-19 are rejected.

Claim Rejections-35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by Ephstein RU Patent No. 2104006 (RU '006) (of previous record).

The claims are drawn to a method of enhancing the activity of an active pharmaceutical substance, comprising combining a therapeutic dose of morphine with a homeopathically activated form of morphine, and that the combination is carried out prior to administration.

Ephstein discloses a method of combining potentiated morphine with the habitual morphine dose to enhance effectiveness of treating withdrawal symptoms (English abstract). It is taught that the potentiated morphine is prepared by successive dilutions according to homeopathic procedure (English language abstract), and that the combination of diluted morphine and habitual amount of morphine is provided during periods of intoxication as well as withdrawal (English abstract). Therefore, as Epshtein discloses a method of enhancing the activity of morphine by combinations of a habitual

amount of morphine with successive homeopathic dilutions of morphine, Epshtein anticipates claim 17.

Claim Rejections-35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 14-16, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epshtein RU Patent No. 2104006 (RU '006), as applied to claim 17 above, and further in view of Epshtein et. al., RU Patent No. 2099052 (RU '052) (both of previous record).

The claims are directed to a method of enhancing the activity of ethanol, comprising administration to a subject suffering from a disorder treatable by ethanol a therapeutic dose of ethanol combined with a homeopathically activated form of ethanol. The claims are also drawn to combining the homeopathic and therapeutic dosages of

morphine or ethanol prior to administration, and that the dilution ratio of the homeopathically activated form to the active pharmaceutical substance is from 1:1 to 1:100.

As discussed supra, the RU ‘006 patent discloses a method of combining morphine prepared by successive homeopathic dilutions with habitual doses of morphine to enhance the effectiveness of treating withdrawal symptoms. The RU ‘006 patent does not explicitly teach a method of enhancing the activity of ethanol, or that the dilution ratio of the homeopathically activated form to the active pharmaceutical substance is from 1:1 to 1:100.

The RU ‘052 patent teaches a method of treating withdrawal symptoms associated with alcohol abuse (intoxication), as well as enhancing the effectiveness of treating neurotic, psychotic, and somatic disorders comprising administration to the subject suffering from these disorders ethanol which has been diluted by homeopathic methods (English language abstract). It is also taught that the homeopathic dose of alcohol is prepared by diluting 100 times (English abstract).

The RU ‘006 patent teaches a method of enhancing the activity of morphine comprising administration to a subject a combination of morphine prepared by homeopathic dilutions along with habitual morphine dosages. The RU '052 patent teaches a method of enhancing the activity of ethanol comprising administration of ethanol prepared by homeopathic dilution. It would have been prima facie obvious, at the time of the invention, to one of ordinary skill in the art, to enhance the activity of ethanol by administering a combination of ethanol which has been prepared by

homeopathic dilutions along a therapeutic dose of ethanol, because the RU '006 patent teaches that this method is effective for enhancing the activity of morphine. Morphine and ethanol are both substances which are known in the art to be associated with substance abuse; as the prior art teaches a method of alleviating symptoms of withdrawal with one substance by administering a combination of a therapeutic dose along with a potentiated dose prepared by homeopathic dilutions, it would have been obvious that this method would also be used to alleviate withdrawal symptoms associated with another substance, such as ethanol. While the RU '006 patent does not explicitly teach that the homeopathic dose and the therapeutic dose would be combined prior to administration, it would have been obvious that, in order to alleviate symptoms and enhance the effectiveness of the treatment, that the dosages would be combined prior to administration. It is also taught by the RU '052 patent that the dilution factor for ethanol to prepare the homeopathic dose is 1:100. Therefore, while the RU '006 patent does not explicitly teach that the morphine is diluted from 1:1 to 1:100 to active substance, it would have been obvious to dilute the morphine within this ratio range, because the RU '052 teaches that this ratio dilution is effective for enhancing the activity of another active substance.

Claim Rejections-35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

> invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 2-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epshtein RU Patent No. 2104006 (RU '006), in view of Epshtein et. al., RU Patent No. 2099052 (RU '052), as applied to claims 14-16, 18, and 19 above, and further in view of Epshtein et. al., PCT/RU01/00239 (PCT '239), and Epshtein et. al., PCT/RU02/00369 (all of previous record). For convenience, the English language equivalent of the PCT/RU02/00369 document, US Patent No. 7,572,441, will be referenced in this rejection. As the PCT '239 document is in Russian, for convenience, the English language equivalent of this document, US Patent Application No. 2003/0099636, will be referenced.

The claims are drawn to a method of enhancing the activity individually of phenazepam, diazepam, hydrocortisone, and cyclophosphamide, comprising administration to an individual suffering from a condition treatable by each active substance a combination of a therapeutic dose of the active substance and a homeopathically activated form of the active substance. The claims are also drawn to the homeopathically activated form prepared by a dilution of 1:1 to 1:100 of active

substance to carrier, and that the combination of the dosages is performed prior to administration.

As discussed supra, the RU ‘006 and RU ‘052 patent teach in combination the method of enhancing the activity individually of morphine and ethanol comprising administering to an individual suffering from a condition treatable by the active substance a combination of a therapeutic dose of morphine or ethanol with a homeopathic dilution of the substances within a ratio range within 1:1 to 1:100.

The RU ‘006 and RU ‘052 patents do not explicitly teach a method of enhancing the activity of phenazepam, diazepam, hydrocortisone, cyclophosphamide, comprising administration to a subject a combination of a therapeutic dose of the active agents and a homeopathically activated form of the active agents.

US Patent No. 2003/0099636 (the US ‘636 publication) teaches that compounds such as phenazepam, diazepam, and hydrocortisone are active pharmaceutical agents used for the treatment of various medical conditions (p. 4, paragraphs [0055-0056]; p. 19, paragraph [0301]). It would have been prima facie obvious for one of ordinary skill in the art, at the time of the invention, to enhance the activity of pharmaceutical agents such as phenazepam, diazepam, and hydrocortisone by the methodology of the combined teachings of the RU '006 and RU '052 patent because the RU '006 and the RU '052 patents teach a homeopathic method of enhancing the activity of morphine and ethanol, which are also used pharmaceutically. As the RU ‘006 and RU ‘052 patents teach a method of enhancing the activity of pharmaceutical agents comprising administration the combination of a therapeutic dose of the active agents with a

homeopathically activated form of the active agents, it would have been obvious that this methodology could also be applied to other pharmaceutical active agents, such as phenazepam, diazepam, and hydrocortisone. As the prior art teaches that an activated form of agents such as morphine and ethanol can be enhanced by administering a therapeutic dose along with a homeopathically activated dose, prepared by dilution to create a ratio of homeopathically potentiated agent to active substance from 1:1 to 1:100, one of ordinary skill in the art would have expected success when using this methodology to enhance the activity of other pharmaceutical agents, such as phenazepam, diazepam, and hydrocortisone.

The RU ‘006, RU ‘052, and the US ‘636 publication do not explicitly teach that the activity of cyclophosphamide can be enhanced by administration of a combination of a therapeutic dose of cyclophosphamide and a homeopathic dose prepared by dilution of cyclophosphamide from 1:1 to 1:100.

The US 7,572,441 (US ‘441) patent teaches that cyclophosphamide is an agent which is used for medicinal purposes (column 2, Example 1, lines 44-62). Therefore, as morphine, phenazepam, diazepam, hydrocortisone, and ethanol are pharmaceutical active agents which have enhanced activity comprising administration of a therapeutic dose combined with a homeopathically activated dosage, it would have been prima facie obvious to one of ordinary skill in the art that cyclophosphamide could also have enhanced activity by the same methodology.

Claim Rejections-Obviousness Type Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 2-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 17, and 19-21 of copending Application No. 09/117838. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims encompass the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The instant claims are drawn to a method of enhancing the activity of a pharmaceutical substance, such as phenazepam, diazepam, hydrocortisone, morphine, ethanol, and cyclophosphamide, comprising administration of a combination of a therapeutic dose of a pharmaceutical substance along with a homeopathically activated form of the substance, in which the substance has been diluted from 1:1 to 1:100. The co-pending

claims are drawn to a method of making a bipathic medication, comprising administration of a therapeutic dose and a homeopathically diluted dose. The method of making a bipathic medication and the method of enhancing the activity of a substance are essentially the same inventive concept, as the method of making a bipathic medication encompasses the claimed method of enhancing the activity of a pharmaceutical substance. Therefore, the claims are not patentably distinct from each other.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

17. No claims allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SARAH PIHONAK whose telephone number is (571)270-7710. The examiner can normally be reached on Monday-Thursday 8:00 AM - 6:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S.P.

/SREENI PADMANABHAN/
Supervisory Patent Examiner, Art Unit 1627